

12-29-'03 10:46 FROM-Lerner & Greenberg

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T-383 P02/07 U-247

Reconsideration

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By: Loren D. Pearson
Loren Donald Pearson

Date: December 29, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirm. No. : 1164
Appl. No. : 10/085,921
Applicant : James E. Harman
Filed : February 28, 2002
Art Unit : 3676
Examiner : Chuck Y Mah
Title : Mug Handle Cover and Method for
Identifying a Mug with a Mug Handle Cover
Docket No. : LDP-8103
Customer No. : 24131

OFFICIAL

RESPONSE UNDER RULE 1.136(a)

Mail Stop No-Fee AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Examiner Mah:

The following remarks respond to the Office action dated
September 29, 2003:

Reconsideration of the application is requested. Claims 1-2,
4-5, and 7-27 remain in the application.

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In item 1 of the Office action, the Examiner rejected claims 25-27 as being fully anticipated by Brennan '949 under 35 U.S.C. § 102(e). As will be explained below, the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, a brief review of the invention as claimed is provided. Claim 25 calls for, *inter alia*, a method for identifying a mug having a handle among a plurality of identical mugs, which includes the following steps:

marking a mug handle cover to be unique; and
releasably attaching the mug handle cover to the mug. (Emphasis added by Applicant.)

While the Examiner stated, "It is certain that Brennan's 'handle cover; is releasable and the 'cover' is not a permanent, monolithic part of the mug handle;" the patent's specification in light of the evidence discussed below show otherwise. Attached find a Declaration under Rule 1.132. In the declaration, the inventor declares that he contacted the inventor of the cited prior art, Brennan. In his conversation, Brennan explained that the invention involved a specially designed mug that had a non-standard handle. The

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non-standard handle only attaches to the mug for which it is intended. Furthermore, the prior art mug and handle are made of three pieces that lock permanently together. The icon on top of the handle is permanently attached and cannot be switched once it is joined.

The specification of Brennan only teaches a permanently attached handle. The handle is only shown attached -- no exploded view of a releasable handle cover is ever taught. The claiming of the mug and handle, as opposed to a handle cover with a mug in phantom, is the only thing taught. In addition, the mouse icon is not detachable. As confirmed by the declaration, the mouse icon was shown in phantom only because different permanent icons could be used.

Accordingly, Brennan does not teach "releasably attaching the mug handle cover to the mug." Accordingly, claim 25 is not anticipated by Brennan. Furthermore, claims 26-27, which depend on claim 25 are patentable for the same reason.

In item 3 of the Office action, the Examiner allowed claims 1-2, 4-5, and 7-24.

In view of the foregoing, reconsideration and allowance of claims 1-2, 4-5, and 7-27 are solicited. In the event the Examiner should still find any of the claims to be

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unpatentable, please telephone counsel so that patentable
language can be substituted.

If an extension of time for this paper is required, petition
for extension is herewith made.

Please charge any other fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Lerner and
Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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